

REMARKS/ARGUMENTS

Claims and Restriction Requirement

Applicants note that the Examiner has instated a further restriction in the present Office Action. In particular, the Examiner has separated claim 1 from claims 3 and 5. In the Office Action, claim 1 was stated as the subject matter of the invention. In a telephone conversation, applicants indicated a desire to pursue method claim 3 in the present application. Since claim 1 was selected by the Examiner, but applicants wish to pursue the invention of claim 3, in this application, applicants respectfully request that claim 3 be examined in the present application. In addition, new claim 10 has been added. This claim is directed to a dopaminergic neuron proliferative progenitor cell selected by the methods of the invention. No new matter is added by this amendment. Finally, the claims have been amended to be directed to SEQ ID NOs: 1 and 3.

Rejection under 35 U.S.C. § 112, first paragraph

The claims stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with enablement requirement. Applicants respectfully traverse.

The Examiner alleges that undue experimentation would be required to make and use probes of the present invention. It is well established that the Examiner bears the initial burden of providing evidence or reasoning why a pending claim does not meet the requirements of §112, first paragraph. The proper test of enablement is “whether one skilled in the art could make or use the claimed invention from the disclosure in the patent coupled with information known in the art without undue experimentation.” *United States v. Telectronics, Inc.*, 8 USPQ2d 1217 (Fed. Cir. 1988). MPEP §2164.01

Applicants respectfully submit that the Examiner has not set forth a *prima facie* case of non-enablement. The presently claimed invention is directed to probes based on SEQ ID NO: 1 and their use to identify dopaminergic neuron proliferative progenitor cells. At the time of the invention the preparation of probes based on a known sequence to identify cells that express a particular gene, was well known. Applicants respectfully submit that the Examiner’s

requirement for specific instructional guidance and reduction to practice of exemplary embodiments is in conflict with the USPTO's own enablement guidelines.

In view of the foregoing, Applicants respectfully submit that one skilled in the art could make or use the claimed invention from the disclosures in the specification, coupled with information known in the art, without undue experimentation. Accordingly, reconsideration and withdrawal of the outstanding enablement rejection in view of the amendments and remarks herein are respectfully requested.

The rejection of the claims for allegedly lacking enablement is also respectfully traversed. The Examiner alleges that the claims encompass subject matter which was not described in the specification in such a way as to convey possession of the claimed invention.

Applicants respectfully disagree with the Examiner's position. Applicants maintain that the Examiner's absolute requirement for actual reduction to practice of exemplary sequences in order demonstrate possession of the claimed invention is in conflict with the statutory requirements as well as the USPTO's own written description guidelines.

It is well accepted that a specification may, within the meaning of 35 U.S.C. 112, first paragraph, contain a written description of a broadly claimed invention without reducing to practice each and every species encompassed by the claims. In fact, the law does not even require that the specification describe the exact details for preparing every species within a claimed genus, much less the actual construction of the species themselves. Moreover, even if the Examiner considers the subject matter of the claims to be broader than that disclosed in the original specification, the written description requirement may be satisfied if the broader concept would naturally occur to one skilled in the art upon reading the earlier specification. As noted above, since the preparation of probes was well known at the time of the invention, one of skill could readily practice the claimed invention.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 1 was rejected for allegedly being indefinite. The claim has been amended to specify the stringent hybridization conditions. Withdrawal of the rejection is respectfully requested.

Appl. No. 10/543,003
Amdt. dated November 15, 2007
Reply to Office Action of May 15, 2007

PATENT

Rejection under 35 U.S.C. § 102(b)

The pending claims stand rejected over the disclosure of US published application No. 20060239978. As the Examiner notes in the Office Action, the '978 application is not prior art if applicants provide evidence that the claimed invention was made by the present inventors. Applicants reserve the right to make such a showing.

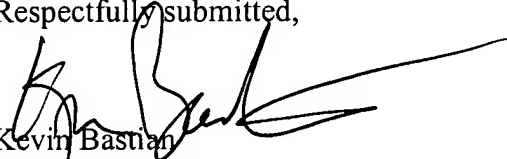
Double Patenting Rejection

Applicants reserve the right to file a terminal disclaimer once the present claims are otherwise in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,


Kevin Bastian
Reg. No. 34,774

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
Attachments
KLB:klb
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